

REMARKS

The 35 U.S.C 112, First Paragraph Rejection

Claims 23-25 have been rejected under 35 U.S.C. 112, first paragraph,

"as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) at the time the application was filed, had possession of the claimed invention."

As earlier pointed out and again reiterated, it took applicants ten years of difficult contesting with the Patent Office to finally obtain on December 14, 1999, U.S. Patent No. 6,002,558 stemming from the parent application filed in 1990;— now only to be met in this divisional application, with further delay by a very belated criticism of the sufficiency of the original disclosure!

Specifically, the Office has invited attention to the phrase in claim 23 reading:

"voice-controlled switching means disposed at said steering wheel region and programmed with a plurality of pre-designated separate voice commands for the respective operation of each of said entertainment deck components and also of the cellular radio telephone, the voice-controlled switching means being responsive to the driver speaking the respective pre-designated commands live at said steering wheel region for thereupon effecting the activating of the corresponding control switch."

Applicants have been at a loss to understand this very belated raising of this rejection ten years after the parent application was filed, when the adequacy of such disclosure in the original parent application (unchanged in the present divisional application and drawings) has been continuously recognized and certainly not criticized by the Office.¹

In fact, the above-mentioned recently issued U.S. Patent 6,002,558, stemming from the parent application and its original specification and claims, contains claims 13 and 14 reciting this very "driver actuated switching ... effected by a driver-

¹ See according "full faith and credit" to earlier examiners actions (704, Manual of Patent Examining Procedures).

operated switch control located at the vehicle steering wheel structure", and "in which the driver actuated switching is effected by driver voice-command actuated switches"!

Original Fig. 2 of the parent application, moreover, also appears in this patent and in the present divisional application as well, specifically labeling the option of the actuation of the recording and other deck components and of the cellular telephone radio transmitter as "AT STEERING WHEEL BY VOICE".

From the original parent application specification disclosure right up to the present divisional application, the substantially unchanged specification fully teaches to those skilled in the art these very features of applicants' original invention, and such has been recognized and unchallenged by the patent examiners for ten years until the throwing up of this new roadblock.

Supporting Quotations From Specification Disclosure

Using references to such original specification, the concept of using a "voice switch" to control the operation of the recording is introduced at the bottom of page 10 of the specification, and is shown in Fig. 1 and in Fig. 3 at 9, where it is designated for controlling both the recording drive and the cellular telephone transmitter.

On page 16, applicants further disclose that "Again, voice switch control 9 is preferred to minimize operator or driver attention and functions". Applicants, however, go much further to aid those skilled in the art in understanding such implementation by giving specific reference to specific useful manufactured equipment components on the market: "such as the voice actuated controls described in said Minisette catalogs or in other well-known recorders of such character" (referring to the "Minisette - 15 and 20 cassette recorders described in respective catalogs 14-1027 and 14-1055A of Tandy Corporation, 1985 and 1988, respectively", on original page 10).

Further on page 16 of the original specification, applicants expand upon the features of voice-controlled switching located at the steering wheel region (as labeled

at the upper left of Fig. 2 in the drawing) for all of the deck components "shown to the left in Fig. 1"; stating clearly

"the controls shown to the left in Fig. 1 may be incorporated at or within the steering wheel structure".

Applicants' specific teaching (the subject matter of the claims in this divisional application) continues:

"and ... the control switches may be actuated by voice-commands".

The specification (page 16) then gets much more detailed as to what these commands are to be and what they are to switch control:

"control switches may be actuated by voice commands, recognized by predesignated voice command words."

The disclosure then gives specific illustrations of such exemplary voice commands and the functions they are to control:

"i.e., the driver-expressed words
"RECORD" (to actuate REC and PL);
"RECORD AND TRANSMIT"
(to actuate REC-TX); etc., or coded words or numbers, now fully implementable by well-known technology".

This demonstrates unequivocally that, from the time of the original parent specification to the present divisional application, continued herein, applicants were certainly in full "possession of the claimed invention" set forth in the claims (claim 23, for example, as above) of

"voice-controlled switching means disposed at said steering wheel region and programmed with a plurality of pre-designated separate voice commands for the respective operation of each of said entertainment deck components and also of the cellular radio telephone";
and,
the voice-controlled switching means being responsive to the driver speaking the respective pre-designated commands live at said steering wheel region for thereupon effecting the activating of the corresponding control switch."

It should further be noted that the claims use the precise words of the original specification: "programmed" (page 14, line 8); "voice switch control" (page 16, lines 3, 4); "control switches may be actuated by voice commands" (page 16, line 15); "at... the steering wheel" (page 16, line 14); "predesignated voice command words" (page 16, line 16), "voice on/off switching" (original claim 2 of parent application); "switching being pre-programmed to enable driver pre-selected option functions" (original claim 3 of parent application); "At steering wheel by voice" (legend at upper left of original Fig. 2 in drawings).

The Examiner Has Not Enlightened Applicants
As To Which Specific Phrase or Word of Claim 23
(for example) Is Not Disclosed

By merely asserting that "the rejection of record is maintained ", without a single word of refutation or disagreement with any one of applicants' detailed showings, as above, that each and every claimed element has been specifically disclosed, the Examiner has merely presented a fiat, rather than providing the specific details of the rejection required under the rules of examining procedure.²

If, accordingly, after review of the above showing of full support for the claimed invention, the Examiner still decides to persist in this unfounded rejection, applicants would respectfully request the Examiner to point out specifically what word or words in any of the claims is not supported in the specification, and why applicants are wrong in their showing and quoting that each and every word and concept actually does find specific response in the original specification.

² See 707.07 (d-f), Manual of Patent Examining Procedures

Specific Sec. 112 Issues Raised In Telephone
Discussion With Examiner Following
Advisory Actions

In an effort to try to understand the Examiner's position in the total absence of any specific refutation or dispute as to applicants' showing of total disclosure – just a repetition of rejection – applicants' attorney had a first telephone discussion with the Examiner following the first advisory action.

At that time, the only issue the Examiner discussed on the telephone as to disclosure was, as reported in the Remarks accompanying unentered Amendment D (of February 28, 2001) that

“the Examiner has questioned that the disclosure embraces voice commands for the AM/FM radio component in the radio-entertainment deck system”.

Applicants therefore proceeded to answer this AM/FM radio question as follows:

First, the specification made clear that while mechanical or gang switches were illustrated, “these functional controls are susceptible of microprocessor control... though, for illustrative and explanatory purposes, they are shown implemented by switches and gang-control lines in Fig. 1 which, in practice, can be software implemented as is well known”. (quoted from page 9).

On page 14, the specification taught that “with the microprocessor control MC and the integration of tape deck and cellular radio telephone systems, the above sets of functions may readily be pre-formatted or pre-programmed for the desired options or modes”.

The specification then further taught that “the controls shown to the left in Fig. 1 may be incorporated at or within the steering wheel structure” (page 16). The very first of the “controls shown to the left in Fig. 1” is “R-REC”, which is directed specifically to the “messages or programs received by the vehicle AM/FM radio receiver RR... by CONNECT C₃ (Fig. 2)... and (OPTION O₆) to record the same with the system of the invention (R-REC, Fig. 1)”, pages 14 and 15.

Applicants are thus at a complete loss to understand how the Examiner could possibly refute this inclusion of the AM/FM radio receiver. Applicants would accordingly respectfully request an explanation if this criticism is maintained.

These "Controls" of the "AM/FM Radio Receiver" RR furthermore are clearly shown by dotted gang lines in Fig. 1 as applied to the left-hand set of MC controls in Fig. 1; and the "Receiver AM/FM Broadcasts" block RR of Fig. 2 is clearly shown and described as associated with switch controls CONNECT C₅, C₃ and C₁.

The specification on page 16 further continues with the disclosure that

"the controls shown to the left in Fig. 1...may be activated by voice commands, recognized by predesignated voice commands ... words or numbers, now fully implementable by well-know technology".

This clearly provides support that the AM/FM Radio is indeed included among the other components for voice command control.

When the further March 23, 2001 advisory action was received, applicants were still afforded no refutation whatsoever of their specific demonstration of this disclosure support – only an unhelpful maintaining of rejection without explanation, and a refusal even to permit legend amendments to the drawings which the Office itself specifically required in the final rejection itself (par. 2, page 2).

But this refusal was again with absolutely no explanation as to what was contained in these proposed legends that did not find support in the original specification – in fact no explanation whatsoever.

This precipitated still a further telephone discussion with the Examiner.

This time, instead of discussing the AM/FM matter he had previously raised, the Examiner now questioned if the proposed drawing legends used the words of the specification..

In an effort again to try to satisfy the Examiner and advance the prosecution of the application, applicants replied as follows:

The proposed label in the control switch panel 3 at the upper left in Fig. 1 describes "predesignated voice commands for each of 1 [the tape deck with its "REC" and "PL" controls], RA and RR" [the AM/FM Radio Receiver].

On page 16 of the specification, it is supportingly disclosed that "the control switches (3) may be actuated by voice commands, recognized by predesignated voice command words".

Each of the control switches REC and PL are shown at the control switch panel 3 and are described on pages 12 and 15 as controlling the recording at RA and playback at PA in the tape deck 1.

Specifically, on page 16:

"the driver-expressed words "RECORD" (to actuate REC and PL)" -- -- -- namely, the switch controls REC and PL connected to the control switch panel 3 for the tape deck 1.

The AM/FM radio receiver RR is similarly shown controlled at R-REC, this also being one of "the controls shown to the left in Fig. 1... (that) may be actuated by predesignated voice command words" (page 16).

As for the label proposed to be added at the bottom left of Fig. 1 to the controls for the modulator of the cellular radio transmitter, it is disclosed on page 12 that the control "REC-TX" controls the application of "modulation signals to the modulator of the cellular telephone transmitter circuit (M¹ in Figs. 1 and 2) and thus to transmit... over the air to the remote station (s) RS ". (See, also, first paragraph of page 15). And, on page 16, this voice command switch activation of the cellular radio telephone is specifically described as "actuated by voice commands... i.e. the driver-expressed words... RECORD AND TRANSMIT, (to actuate REC-TX)" -- that is, the actuation of the controls of the cellular telephone modulator.

It is therefore respectfully submitted that the proposed labels on the drawings fully comply with the earlier requirement for showing what is described in the specification and precisely what is claimed.

In the event, however, that the Examiner prefers only the exact words of the specification instead of numbers in the legends, a further proposed drawing

amendment is submitted herewith that only quotes the words of the specification.

Approval is respectfully requested.

The 35 U.S.C. 103 Rejection

Applicants turn, lastly, to the 35 U.S.C. 103 further rejection of claims 14, 16-20 and 22-27 as the "obvious" incorporation into the system of the Japanese patent to Sano et al of the voice-controlled switching mechanism of the patent to Sato et al.

What The Japanese Patent To Sano
Actually Discloses and What It Does
Not Teach And Cannot Do

The purpose of the patent to Sano is to answer an incoming call on a mobile telephone set in an automobile when the driver is unable to talk, with a pre-recorded voice message. This is effected by pressing a button on the steering wheel which, in the words of the English description, activates "a tape recorder or the like, which sends recorded (voice) messages... via the controller 3... to the opposite party" informing the caller, for example, that the driver is "too busy to answer", etc. and that the caller should "leave your message on this recorder".

At most, this only teaches the answering of the car telephone with a pre-recorded message initiated by a steering wheel button.

It has nothing whatever to do with applicants' concept of the driver speaking pre-designated commands that control the cellular telephone switching.

If the Examiner disagrees, an explanation is respectfully requested of where Sano teaches, suggests or even hints at a driver speaking live predesignated commands to control cellular telephones or, for that matter, anything else.

While the Office calls attention to the fact that "Fig. 3 (shows) a driver operated vehicle with an entertainment deck", nowhere does the patent disclose or even hint at any switching, remote or otherwise, of such entertainment deck, and certainly is totally silent on any voice-controlled switching of the entertainment deck.

Again, if the Examiner disagrees, he is respectfully requested to aid applicants in finding where Sano makes any such disclosure or suggestion, since applicants, as above shown, cannot find even a hint.

What The Patent To Sato et al Actually Discloses
And What It Does Not Teach And Cannot Do

As for the patent to Sato et al., this deals with "a voice-operated starter (circuit) for... automatic starting of the tape recorder from a remote location" (col. 1, lines 37, on).

The implementation involves pre-voice-modulating an FM wireless transmission, receiving that transmission in a FM tuner 29, demodulating the voice signal therefrom, and feeding the demodulated signal "to the voice-operated starter circuit (2)... to start the operation of the tape recorder... thus allowing a voice input to the microphone assembly 30 to be recorded on tape 42" (col. 7, line 13, on) of "a miniature size cassette tape recorder" (col. 1, line 55).

While from a broad viewpoint, the Office is correct that this broadly involves "a voice-controlled switching mechanism" (page 4), the Office, however, is totally incorrect in interpreting that

"Sato et al shows in Fig. 1 an entertainment deck including storage medium player and an AM/FM radio-receiver".

The patent to Sato et al has in fact absolutely nothing whatever to do with any AM/FM radio receiver, any entertainment deck system, and certainly not a vehicle entertainment deck system; nor is it concerned with drivers of vehicles, as such - - dealing only generically with portable "miniature size cassette tape recorder(s)" that are started by an FM wireless signal demodulated as a voice signal.

Once more, if the Office persists in this position, it is again respectfully requested to point out where Sato et al uses a vehicle entertainment deck, since, as above demonstrated, applicants find this reference barren of any such deck.

This patent, moreover, has absolutely nothing to do with applicants' driver live voice commands to actuate respective different components of vehicle entertainment decks and a cellular phone.

There is also not one word, let alone even a hint or suggestion, in the patent that any concepts or teaching therein were directed to, or useful in, the solution of

applicants' problem of providing diversionless driving in a vehicle. The very different problem underlying the Sato et al patent, to the contrary, being to prevent "interference" (col. 5, line 4, col. 7, line 7) by unwanted voice signals during broadcasting through use of the intermediary of the FM transmission of the modulated desired recorded voice signal for starting the recorder.

This is clearly unrelated to applicants' novel approach wherein drivers give direct and live voice switching commands right at the steering wheel region of vehicles, as specifically recited in the claims, to actuate respective multiple components of a vehicle entertainment deck and also a cellular telephone, selectively.

Even Were Sano and Sato et al Somehow
Combined, This Would Not Meet The
Concept Or Wording Of The Claims

Even if, moreover, the full circuit of Sato et al were to be somehow incorporated into the system of Sano et al, though there is no suggestion in either reference or motivation for such a combination, the use of the voice-controlled switching mechanism of Sato et al would hardly actually accomplish in the system of Sano et al, the kind of voice-controlled switching required by applicants' claims; namely,

voice-controlled switching means disposed at said steering wheel region and programmed with a plurality of pre-designated separate voice commands for the respective operation of each of said entertainment deck components and also of the cellular radio telephone; the voice-controlled switching means being responsive to the driver speaking the respective pre-designated commands live at said steering wheel region for thereupon effecting the activating of the corresponding control switch.

The Examiner Is Believed To Have Failed To
Perform The Duty Required By Law
In Connection With Prior Art Rejection

As above shown, applicants have demonstrated (and quoted from the references) that Sato et al does not, as incorrectly stated by the Examiner, show in "Fig. 1 an entertainment deck including storage medium player and an AM/FM radio receiver"; and further, that there is not one word, let alone even a hint or

suggestion in the patent, of "driver live voice commands" to actuate respective different components of vehicle entertainment decks and/or a cellular phone.

Again, the Examiner, has utterly failed to show applicant's demonstration of the above facts to be in error, and has merely "maintained" the rejection leaving applicants in the dark.

And, as for the patent to Sano, the Examiner has further failed to refute applicants' facts quoted from the reference that it also has nothing to do with applicants' further claimed concept of the driver speaking live pre-designated commands that control the cellular telephone switching as claimed; and that Sano neither discloses any switching, remote or otherwise, of the entertainment deck... and certainly is totally silent on any voice controlled switching of any entertainment deck.

The Examiner has not provided a single word of refutation or disagreement with any of applicants' detailed showings of the above facts, and has merely "maintained" a rejection as a fiat, apparently unconcerned with the absolutely contrary facts demonstrated by applicants.

Again, therefore, should the Examiner, after review of the above, decide still to persist in its unfounded statements as to the prior art, applicants would also respectfully request the Examiner to point out where Sato et al "shows in Fig. 1 an entertainment deck including storage medium player and an AM/FM radio receiver"; and where the reference discloses or even hints at "driver live voice commands to actuate respective different components of vehicle entertainment decks and a cellular phone". Also, where Sano has any bearing on "drivers speaking pre-designated commands that the control cellular telephone switching", or "discloses any switching... of the entertainment deck" etc. — all specific limitations of the claims.

Such an explanation may afford applicants an understanding of specific issue bases for appeal, if required, which is not provided on the present record.

Newly presented claims 28,29 and 30, track respective claims 24, 25 and 26. Claims 28 and 30 make it very clear that the claims require a plurality (not just one) of pre-designated separate voice commands for the operation of a corresponding

plurality of the entertainment deck components and of the cellular telephone as well (and the latter, separately, in claim 29).

Applicants submit, moreover, that there is no way that any possible combination of the patents to Sano et al and Sato et al can respond to the specific language limitation requirements of the claims (such as claim 28), particularly as amended, of

“voice-controlled switching means disposed at said steering wheel region and programmed with a plurality of pre-designated voice commands for operation of said components and also of the cellular radio telephone; the voice-controlled switching means being responsive to the driver speaking such pre-designated commands live at said steering wheel region for thereupon effecting the actuating of the corresponding control switch.”

Precisely the same voice-controlled switching means

“responsive to the driver speaking such pre-designated commands live at said steering wheel region for thereupon effecting the activating of said control switch”

is required, also, by claims 29 and 30.

The Examiner, if still persisting in this rejection, therefore, is specifically requested to aid applicants' understanding by reading each phrase above quoted from claim 28 on the combined references, element for element. As above shown, applicants are presently at a loss to understand how the Examiner can possibly find the claims met.

Reconsideration and allowance are thus believed to be in order and are respectfully requested.

The Law of Obviousness

And, in such connection, applicants would respectfully call the attention of the Office to the recent admonitions of the Court of Appeals for the Federal Circuit against the present type of rejection offered by the Examiner - -

[(In Re Roufett, 149 F3d 1350, 47 U.S. P.Q. 2d 1453 (Fed. Cir. 1998)]:

“...the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness”.

The Examiner has failed to show such "suggestion yo combine" or motivation in either

reference, and, in fact, there is none in these references.

And, in In re Dembiczak, 1751 F.3d 994, 50 U.S.P.Q. 2d (Fed. Cir. 1999), the Court also criticized

"the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher".

Neither Sano nor Sato et al, or any possible reading of their disclosures teaches or even hints at either applicants' results, or what the express limitations of applicants' claims require. This "hindsight" clearly impermissibly came only from applicants' teachings.

Any costs, in connection with the filing of this continuing application and including for extensions of time required herein, and in the parent application S.N. 09/039,176, petition for which is hereby made, are to be charged to Deposit Account No. 18-1425 of the undersigned attorney.

Respectfully submitted,

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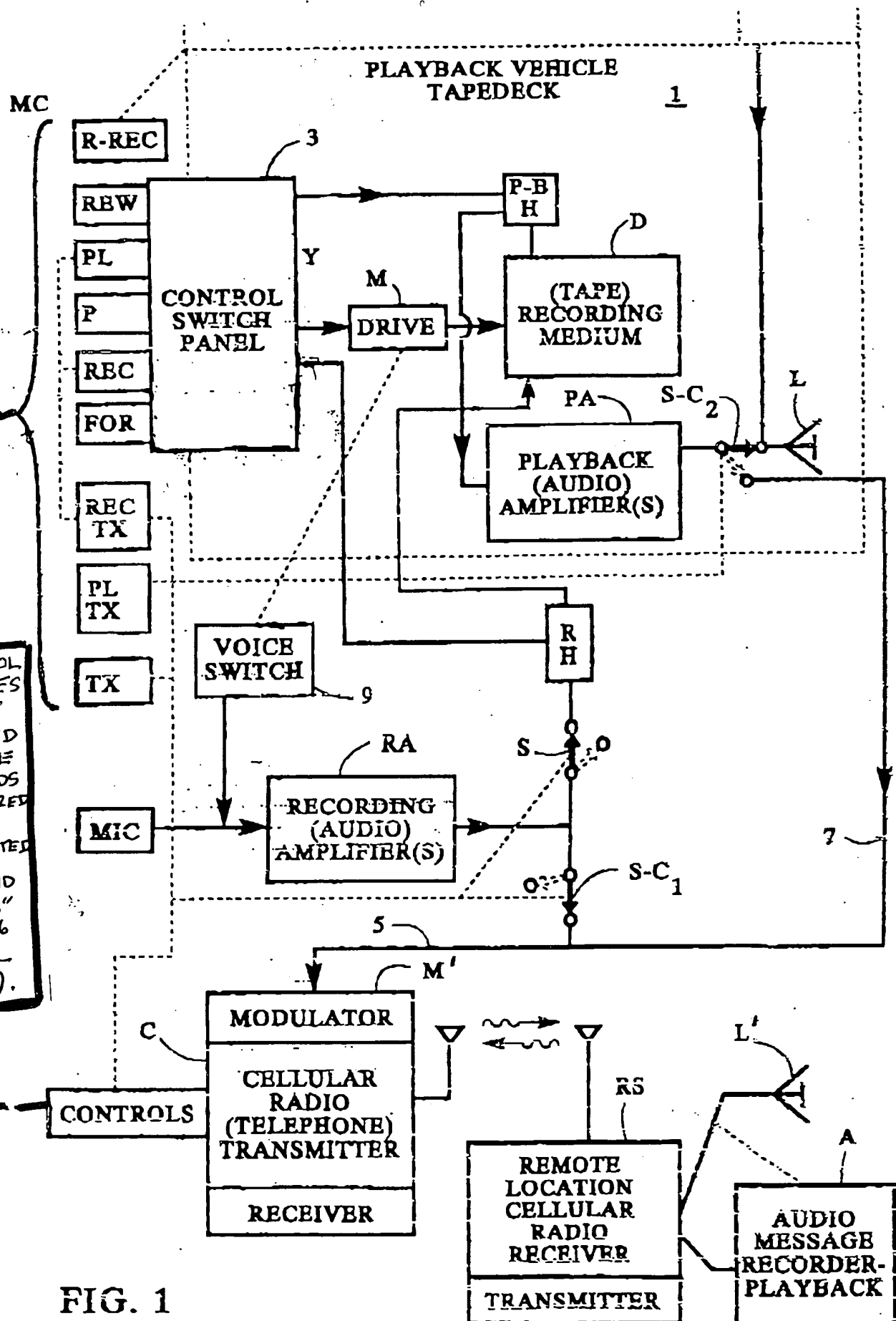


FIG. 1